

REMARKS/ARGUMENTS

Claims 7, 8, 14-16, 19-20 and 28-34 remain pending in the present application, of which claims 1, 15, and 33 are independent. Claims 7, 14-15, and 31-32 have been amended herein. Claims 33 and 34 are new. Claim 30 has been withdrawn. Applicants respectfully request reconsideration and allowance of claims 7, 8, 14-16, 19-20, 28-29, and 31-34.

Please note that the title has also been slightly amended to correct a clerical error.

I. Interview Summary

An in-person interview was conducted on May 4, 2009, between Examiner Willse and Applicants' attorney Mark Garscia. In the interview, the parties discussed the 35 U.S.C. § 102(e) rejection of claim 7 over U.S. Patent No. 7,066,958 to Ferree, and the 35 U.S.C. § 102(b) rejection of claim 7 over U.S. Patent No. 6,375,682 to Fleischmann et al. ("Fleischmann").

With respect to the 35 U.S.C. § 102(b) rejection over Fleischmann, the Examiner indicated that a proposed amendment to claim 7 specifying, "wherein the sliding engagements provide for rotational movement of the top plate and the base plate substantially about a central axis of the core extending from the upper body to the lower body, and respective sliding movement of the top plate and the base plate from first angular positions relative to the central axis of the core to second angular positions relative to the central axis of the core," would help distinguish over Fleischmann.

With respect to the 35 U.S.C. § 102(e) rejection over Ferree, the Examiner indicated that a proposed amendment to claim 7 specifying, "wherein the core comprises an upper body defining the curved surface on the side facing the top plate, a lower body defining the curved surface on the side facing the base plate and an annular intermediate elastic body between and entirely separating the upper and lower bodies to provide cushioning for the prosthesis," would help distinguish over Ferree.

Applicants have accordingly amended independent claim 7 based on the discussion with respect to Fleischmann, and have further incorporated the amendments with respect to Ferree in

new independent claim 33. Further discussion of these amendments is presented below. Applicants' attorney thanks the Examiner for his time and consideration.

II. Information Disclosure Statement

The Examiner indicates that two references in Applicants' November 7, 2008 Information Disclosure Statement were not considered, because in the copies of DE 2 263 842 and WO 01/68003 A1, one of the pages was fragmented or incomplete.

Applicants are providing with this amendment full and complete copies of the references DE 2 263 842 to Hoffmann-Daimler and WO 01/68003 A1 to Viart et al., along with a clean copy of the corresponding Form PTO/SB/08A/B submitted on November 7, 2008 and available on PAIR for the Examiner's convenience, and respectfully request that the Examiner consider the references prior to the next communication from the Patent Office, and provide a signed and initialed copy of the Form PTO/SB/08A/B indicating the same with the next communication.

III. Objection to Claim 31

Claim 31 was objected to over a clerical error. Applicants have amended claim 31 in accordance with the Examiner's suggestion, and request the objection to claim 31 be withdrawn.

IV. Rejection of Claims 15 and 16 Under 35 U.S.C. § 112

Claims 15 and 16 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 15 has been amended to specify, "wherein the core has a bore extending from the base plate through the intermediate elastic body to the top plate and wherein a connecting sleeve is provided within the bore of the intermediate elastic body to engage the base plate and the top plate." As amended, the claim provides sufficient antecedent basis. Accordingly, Applicants request the 35 U.S.C. § 112 rejections of claims 15-16 be withdrawn, and that these claims be allowed. Applicants further request that new dependent claim 34, which depends from claim 15 and incorporates all the terms and limitations of claim 15, also be allowed.

V. Rejection of claims Under 35 U.S.C. § 102

A. Disqualification of Ferree as a Prior Art Reference

Claims 7, 14, 28-29, and 31-32 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by FIG. 28C of US. Patent No. 7,066,958 to Ferree. Claims 8 and 19-20 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over FIG. 28C of Ferree.

To qualify as a 102(e) reference, an invention must be described in “(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.” The effective filing date of Ferree under 102(e) is May 9, 2003, its U.S. filing date. While Ferree claims priority to Provisional Application No. 60/379,462, and is a continuation-in-part of Patent Application No. 10/422,282, the embodiment of Ferree illustrated in FIG. 28C does not appear to be properly supported in either of these references. Therefore, the embodiment of Ferree illustrated in FIG. 28C constitutes new matter which cannot claim the earlier filing dates of the related references. Since the instant application claims priority of German Patent Application No. DE 102 42 329.6, filed with the German Patent and Trade Mark Office on September 12, 2002, Ferree was not filed in the United States before the priority date of the instant application. Applicants are providing with this amendment a verified translation of the priority document, DE 102 42 329.6, filed on September 12, 2002, with the German Patent and Trade Mark Office. Applicants submit that this German priority document provides sufficient disclosure to be a basis for the claims of the present application.

Therefore, Applicants submit that Ferree does not qualify as a proper prior art reference from which a rejection may be made. Accordingly, Applicants request that the respective rejections of claims 7-8, 14, 19-20, 28-29, and 31-32 over Ferree be withdrawn.

B. 35 U.S.C. § 102(b) Rejection Over Fleischmann

Claim 7 was also rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,375,682 to Fleischmann.

Independent claim 7, as amended, specifies in relevant part, “wherein the sliding engagements provide for rotational movement of the top plate and the base plate substantially about a central axis of the core extending from the upper body to the lower body, and respective sliding movement of the top plate and the base plate from first angular positions relative to the central axis of the core to second angular positions relative to the central axis of the core.” (emphasis added).

In rejecting claim 7, the Examiner asserts that Fleischmann discloses, “a core having curved surfaces defined by ball bearing members 44 and inner surfaces of radial bearing 24 (Figure 1c). The top and bottom plates have curved sections and the annular grooves 48 and at the hubs affixed by screws 50.” Office action, p. 3.

However, Fleischmann does not disclose the above specified limitations of amended claim 7. Referring to FIG. 1C of Fleischmann, ball bearings 44 and radial bearing assembly 24 only provide for rotational movement in Fleischmann, but do not provide for “sliding movement of the top plate and the base plate from first angular positions relative to the central axis of the core to second angular positions relative to the central axis of the core.” Since Fleischmann does not disclose all the elements and limitations of claim 7, a 35 U.S.C. § 102(b) rejection is not proper. Accordingly, and in light of the discussions during the May 4, 2009 interview, Applicants request that the rejection of claim 7 be withdrawn, and that claim 7 be allowed.

Claims 8, 14, 19-20, 28-29, and 31-32 depend, directly or indirectly, from claim 7, and each incorporates all the terms and limitations of claim 7, in addition to other limitations, which together further patentably distinguish them over Fleischmann. Accordingly, Applicants request that the rejection of claims 8, 14, 19-20, 28-29, and 31-32 be withdrawn, and that these claims be allowed.

Appln No. 10/660,452
Amdt date June 22, 2009
Reply to Office action of January 21, 2009

VI. Further Comments Regarding New Independent Claim 33

The claimed embodiment of new independent claim 33 incorporates both the amendments discussed during the May 4, 2009 interview. As Ferree is not believed to be a proper 102(e) reference, the rejections of claim 7 are believed to be overcome without the proposed amendments discussed with respect to Ferree. The claimed embodiment of new claim 33 further includes said proposed amendments discussed with respect to Ferree. Accordingly, Applicants submit that new independent claim 33 is allowable as presented.

VII. Concluding Remarks

In view of the foregoing remarks and arguments, Applicant earnestly solicits a timely issuance of a Notice of Allowance as pertains to claims 7, 8, 14-16, 19-20, 28-29, and 31-34. If there are any remaining issues that can be addressed over the telephone, the examiner is cordially invited to call Applicants' attorney at the number listed below.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By 

Joshua T. Chu
Reg. No. 59,799
626/795-9900

JTC/rmw

JTC PAS846462.3-* -06/22/09 11:17 AM